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EXAMINER

BELIVEAU, SCOTT E

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

MAILED

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Technology Center 2600

Application Number: 09/590,434
Filing Date: June 09, 2000
Appellant(s): JERDING ET AL.

Mr. Anthony F. Bonner Jr.
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 05 January 2007 appealing from the Office action
mailed 11 May 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct. No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,628,302	WHITE et al	9-2003
5,838,314	NEEL et al	11-1998
5,914,746	MATTHEWS, III et al	6-1999
5,585,838	LAWLER et al	12-1996
5,929,849	KIKINIS	7-1999
5,907,323	LAWLER et al	5-1999

Bee, Dixie Reid "Coming Attractions before they hit the big screen, most films begin life as a trailer" The Sacramento Bee, July 18, 1996, pg. E. 1

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

1. Claims 134 and 135 are rejected under 35 U.S.C. 103(a) as being unpatentable over White et al. (US Pat No. 6,628,302), in view of Neel et al. (US Pat No. 5,838,314), in view of the Bee article, and in further view of Matthews, III et al. (US Pat No. 5,914,746).

In consideration of claim 134, the Figure 1 of the White et al. reference illustrates a "television set-top terminal ("STT")" [14] "coupled to a server" [12] via a "bi-directional communication network" [16]. The "set-top terminal" [14] comprises a "memory having program code stored therein" [40/42] (Col 3, Lines 1-8) and at least "one processor that is

programmed by the program code to enable the STT” [38] (Col 2, Lines 63-67). The system is operable to “receive via tuner in the STT media guide data corresponding to a media guide for on-demand rentable video presentations” (Col 3, Lines 28-40) and “provide a media guide presentation to a user via a television signal” (Figure 4) wherein the “media guide presentation comprises at least a portion of said media guide data corresponding to a plurality of on-demand rentable video presentations (Col 4, Lines 12-38).

The system “receives a first user input corresponding to a selection of one of the plurality of on-demand rentable video presentations in the media guide presentation” (Col 4, Lines 12-38) and in response provides a billing option screen which is considered to be “responsive to presentation specific rent flags received from the server” associated with the HTML-based primitives utilized to instruct the “STT” [14] to derive/render the user interface. The reference, however, is silent with respect to the particular provisioning of rental options. In an analogous art pertaining to television systems and the field of media-on-demand, the Neel et al. reference discloses a media-on-demand system that “enables a plurality of user selectable rental options specific to each one of the plurality of on-demand rentable video presentations” (Col 13, Lines 34-45; Col 18, Lines 10-42) such that particular advertisements and particular options are provided in accordance with the advertisers instructions. The specification does not clearly support or disclose that the claimed “options” are necessarily separately/independently selectable (IA: Page 21, Lines 28-32). The “STT” [120] subsequently “configures a first rental option in the plurality of selectable rental options to provide a viewer selectable option to view a user-

selected on demand rentable video presentation without presentation promotional advertising that is otherwise shown during the presentation of the user-selected on-demand rentable video presentation” and “configure a second rental option in the plurality of user-selectable rental options to provide a user-selectable option to view a user-selected on-demand rentable movie presentation without preceding [advertisements] that are otherwise shown immediately prior to presentation of the user-selected on-demand rentable video presentation” (Figure 7A; Col 14, Line 49 – Col 15, Line 66). In particular, the user is provided with options to watch none or one or more advertisements before, during, or after the transmission of the video program that are otherwise displayed if the user desires to watch the movie for a reduced price. The “STT” [120] subsequently “receives a second user input responsive to providing the first rental option and the second rental option” [606] (Col 17, Lines 45-66) wherein the “STT” [120] “provides the one of the plurality of rentable video presentations to the user without presentation promotional advertising during the presentation and without preceding [advertising] responsive to the second user input corresponding to the selection of the first rental option an the second rental option” [638] in accordance with presenting the movie in response to the users preferences (Figure 4). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made so as to modify the White et al. billing option screen such that the “STT” [14] “responsive to presentation specific rental flags received from the server, enable a plurality of user-selectable rental options specific to each one of the plurality of on-demand rentable video presentations in the media guide presentation; configure a first rental option in the plurality of user-

selectable rental options to provide a user-selectable option to view a user-selected on-demand rentable video presentation without presentation promotional advertising that is otherwise shown during presentation of the user-selected on-demand rentable video presentation; configure a second rental option in the plurality of user-selectable rental options to provide a user-selectable option to view a user-selected on-demand rentable video presentation without preceding [advertisements] that are otherwise shown immediately prior to presentation of the user-selected on-demand rentable video presentation; receive a second user input responsive to providing the first rental option and the second rental option; and provide the one of the plurality of rentable video presentations to the user without presentation promotion advertising during the presentation and without preceding [advertising] responsive to the second user input corresponding to the selection of the first rental option and the second rental option” for the purpose of offering and providing video-on-demand services wherein the users can advantageously choose on a transaction by transaction basis to have advertisers or other third parties pay for these services (Neel et al.: Col 2, Lines 49-61).

With respect to the particular usage of a species of advertising or “movie trailers”, the Neel et al. reference is silent with respect to the preceding advertisements being “movie trailers” nor does it preclude the particular type of advertisement being presented. In an analogous art pertaining to television systems, the Bee article provides evidence as to the existence of “movie trailers” in the television environment as well as the fact that movie trailers are advertisements that precede the feature presentation. Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was

made so as to particularly utilize “preceding movie trailers” as the disclosed proceeding advertisements of Neel et al. for the purpose of developing recognition and creating a desire to see the particularly advertised movie as taught by the Bee article.

The combined references and in particular the White et al. reference discloses the ability to “suspend the provision of the rentable video presentation” (Col 5, Lines 46-58). The White et al. reference further incorporates by reference the particular features of an electronic program guide such as that disclosed by Lawler et al. (US Pat No. 5,58,838) (hereafter ‘838) (Col 5, Line 58 – Col 6, Line 15). The Lawler et al. (‘838) reference discloses an independent program guide application which provides “promotional advertising . . . configured by the server” [26] in the form of video previews for upcoming programming (Col 6, Lines 11-17; Col 10, Lines 28-56). The reference, however, is not clear with respect to the “particular display of promotional advertising responsive to third user input” associated with changing channels. In particular, the reference is unclear with respect to how the electronic program guide with its associated promotional advertising is necessarily activated. In an analogous art pertaining to the field of television systems and in particular media-on-demand, the Matthews, III et al. reference teaches a method whereby independent electronic program guide and video-on-demand applications are allocated to separate channels (Figure 3; Col 3, Lines 11-67). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made so as to modify White et al. so as to associate an independent electronic program guide application with a separate channel for the purpose of providing a means to advantageously select between various services simply by tuning

to the associated service channel (Matthews, III et al.: Col 2, Lines 3-43). Therefore, taken in combination, the references disclose “suspending the provision of the rentable video presentation responsive to a third user input” corresponding to changing channels to the independent electronic program guide application, “wherein the suspension promotion advertising” associated with various video previews for future programming “provided during suspension of the presentation is configured by the server and is independent of the particular presentation” previously viewed by virtue of the fact that EPG is a separate application and the user can view previews for other programming. It is also “independent of the first rental option and the second rental option” because the particular displayed trailers are independent of or are for different presentations than the suspended presentation and the particular application through which they are presented is a separate and distinctive application.

In consideration of claim 135, the White et al. reference also explicitly incorporates the Lawler et al. (US Pat No. 5,907,323) (hereafter ‘323) reference with respect to aspects of electronic program guides (Col 5, Lines 58-66). The Lawler (‘323) reference discloses that it is desirable for program guides to provide more detailed information regarding upcoming programming which includes video previews or “movie trailers provided through a movie trailer channel to which the STT tunes” in association with the presentation of the programming guide (Figure 5; Col 2, Lines 28-37; Col 9, Lines 33-48). The Lawler et al. (‘323) is silent with respect to further providing an option to order a program for which there is a movie trailer. The Lawler et al. (‘838) reference, previously noted as also being incorporated by reference into White et al., teaches that in

association with an electronic program guide that it desirable to provide with enhanced program guide interactivity and that a user viewing a preview is “provided an option to purchase for future rental at least one movie corresponding” to the preview (Figure 8; Col 6, Lines 7-21; Col 10, Lines 42-56; Col 14, Lines 30-48). Accordingly, it would have been obvious one having ordinary skill in the art at the time the invention was made so as to modify the electronic program guide of Lawler et al. ('838) so as to employ the teachings corresponding to “movie trailers provided through a movie trailer channel” of Lawler ('323) for the purpose of providing enhanced program information to viewers (Lawler ('323): Col 2, Lines 28-37) and to subsequently utilize the teachings of the combined references as an electronic program guide as expressly taught/incorporated by White et al. Therefore, taken in combination, the “suspension promotional advertising provided during suspension of the presentation corresponds to movie trailers provided through a movie trailer channel to which the STT tunes during the suspension of the presentation” in responsive to the user suspending the presentation in association with changing the channel to view the electronic program guide and displaying preview information for available orderable presentations “wherein the user is provided an option to purchase for future rental at least one movie corresponding to the movie trailers during the suspension of the presentation” in association with the displayed order button in the electronic program guide application.

2. Claims 136-138 are rejected under 35 U.S.C. 103(a) as being unpatentable over White et al. (US Pat No. 6,628,302), in view of Neel et al. (US Pat No. 5,838,314), in

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view of the Bee article, in view of Matthews, III et al. (US Pat No. 5,914,746), and in further view of Kikinis (US Pat No. 5,929,849)

In consideration of claims 136-138, as aforementioned, the Neel et al. reference discloses the particular usage of interactive commercials. The reference, however, is silent with respect to what is necessarily displayed in those commercials such that the “presentation promotional advertising corresponds to logos” or “brands”, or “marks provided to the user with the one of the plurality of rentable video presentations”. In an analogous art pertaining to television systems, the Kikinis discloses interactive commercials or advertisements which comprises “logos”, “brands”, or “marks” (Figure 2A) coinciding with an automobile. Accordingly, it would have been obvious to one having ordinary skill in the art so as to modify the “presentation promotional advertising” of Neel et al. so as to utilize advertising such as that provided by Kikinis for the purpose of providing a means by which to easily and quickly access information detail about products advertised (Kikinis: Col 2, Lines 52-59).

(10) Response to Argument

In response to appellant’s arguments, the examiner respectfully disagrees that the rejection should be reversed. The only argument being raised is whether or not the combination of references disclose, teach, or suggest, either implicitly or explicitly all elements/features/steps of claim 134 (Section VII – Arguments). This is the only argument

being considered and addressed in the Examiner's Answer.¹ Any further arguments regarding other elements or limitations not specifically argued or any other reasoning regarding deficiencies in a prima facie case of obviousness that the appellant could have made are considered as having been conceded by the appellant for the basis of the decision of this appeal. They are not being addressed by the examiner for the Board's consideration. Should the panel find that the examiner's position/arguments or any aspect of the rejection is not sufficiently clear or a particular issue is of need of further explanation, it is respectfully requested that the case be remanded to the examiner for further explanation prior to the rendering of a decision.²

Rejection of Independent Claim 134

Appellants argue that the combination of reference fails to disclose, teach, or suggest "a first rental option . . . to view a user-selected on-demand rentable video presentation without presentation promotional advertising that is otherwise shown during presentation of the user-selected on-demand rentable video presentation [and] a second rental option in the plurality of user-selectable rental options to provide a user-selectable option to view a user-selected on-demand rentable video presentation without preceding movie trailers that are otherwise shown immediately prior to presentation of the user-selected on-demand rentable video presentation". The examiner respectfully disagrees.

¹ It is respectfully noted that these arguments had been previously presented and considered in accordance with the Pre-Appeal Brief Conference Pilot Program (OG: 12 July 2005) and were not found to be persuasive by the panel as indicated in the mailing of Pre-Appeal decision mailed on 28 September 2006.

² See 37 CFR 41.50(a)(1) and MPEP 1211

Separate 'first' and 'second rental option' are not disclosed in the application

As noted in the Final Rejection (reproduced above), the specification does not provide enabling support for the particular usage of a separate and distinctive 'first' and 'second rental option' as claimed. The specification states that:

"As another rental option, the user may select to view a MOD title without any promotional advertising. As a non-limiting example, a user, upon selecting such an option, may view a MOD title without any movie trailers commonly shown in movie theaters prior to the feature presentation. As another non-limiting example, the MOD title may be presented to the user without any advertising logos, brands, or other marks that might otherwise be included in the presentation of the MOD title" (IA: Page 21, Lines 28-32).

The drawings provide no further insight into the particular usage or meaning of a 'first' and 'second rental option' as claimed.³ The cited passage only seems to support the particular usage of a single 'option' that is operable to turn off all promotional advertising which would also include any movie trailers that would otherwise be shown. Accordingly, the examiner concluded, in light of the specification, that the claimed 'first' and 'second rental option' are actually referring to the same representative single 'option' (button, toggle, switch, etc.) that logically facilitates or performs two operations namely turning off all promotional advertising and turning off movie trailers. In essence, the system provides the user with either two choices 1) to watch the movie with advertisements before, after, or during the movie or 2) to watch the movies without advertisements. To conclude and/or argue that the 'first' and 'second options' are somehow separate and/or distinctive (ex. you can turn off one

³ The Final Rejection objected to the drawings as not showing the claimed feature of distinctive 'rental options' (ex. separate buttons). Applicant traversed the objection on the grounds that it was not necessary for the understanding of the invention (Page 5, Para. 3). The examiner inquired (Advisory Action - 26 July 2006) whether it was not necessary because it should be considered 'conventional'. Appellants have not commented on this inquiry to date.

type of ads without turning off the other), is simply not supported in the specification and would result in the claims being rejected under 35 U.S.C. 112 1st paragraph for containing new matter.

Combined teachings of Neel and Bee teach the argued limitations

Appellants note that Figure 7A of Neel et al. reference illustrates that the user is provided with 'selectable options' for the user to choose (or conversely not to choose) to watch one or more commercials/advertisement in association with an on-demand presentation. Therefore, applicants argue that the reference fails to teach or suggest the usage of a "a first rental option . . . to view a user-selected on-demand rentable video presentation without presentation promotional advertising that is otherwise shown during presentation of the user-selected on-demand rentable video presentation [and] a second rental option in the plurality of user-selectable rental options to provide a user-selectable option to view a user-selected on-demand rentable video presentation without preceding movie trailers that are otherwise shown immediately prior to presentation of the user-selected on-demand rentable video presentation".

The examiner respectfully notes that Figure 7A is simply one illustrative embodiment. As relied upon and noted in the grounds of rejection, the reference states that:

"[The interactive graphic] screens explain to the customer that, as an alternative to paying for a pay-per-view video program, the customer can choose to watch one or more commercials . . . These commercials can be of a certain duration and can be shown at a specific time before, during, or after the transmission of the video program" (emphasis added) (Col 14, Lines 56-67)

The examiner construes this passage as describing/suggesting a number of scenarios. For example, it would appear to support the user being provided with a single advertisement option to watch one or more commercials which simply appear at different points in time in the presentation similar to that illustrated in Figure 7A or that the system provides the user with a plurality of choices (not illustrated in Figure 7A) with respect to different combinations of number and time (ex. choose to watch one commercial at beginning of movie or choose to watch one commercial at beginning and one at the end, etc.). In any event, Neel clearly teaches that the user is provided with 'options' to watch various commercials at specific time before, during, or after the transmission of the video program (Col 14, Lines 56-67). These commercials or 'promotional advertising' are displayed should the user wish to receive a discount. Subsequently, the illustrated 'option #1' in Figure 7A serves as both the claimed 'first' and a 'second option' to view the presentation without any of the one or more advertisements that would be otherwise shown during the presentation in order to receive a discount. Neel, however, is silent with respect to the usage of 'movie trailers'.

Regarding the nature of the advertising being displayed, Neel teaches that the advertisements may consist of a combination of audio, video, and graphics (Col 15, Lines 2-4) and could be based on a number of criteria (Coil 18, Lines 24-42). As previously noted, Neel teaches that advertisements may be presented 'preceeding' or at the start of the presentation. While the reference makes specific reference to a 'promotional advertisement' for a product such as an automobile, it is generally silent with respect to the particular display of other forms of advertisements that may be further presented as the 'one or more

commercials'. The Bee reference was subsequently provided in the Final Rejection as an evidentiary showing with respect to support existence of 'movie trailers' that 'precede' a movie presentation or can be used within television distribution systems as well as how their usage increases sales.⁴ The examiner subsequently concluded that one having ordinary skill in the art would have been sufficiently motivated to use 'movie trailers' as part of the 'one or more advertisements' whereupon these advertisements may or may not be presented in the manner prescribed in Neel. Accordingly, taken in combination, it is the examiner's opinion that the combination of references meet the argued claimed limitations since choosing to watch a movie without advertisements at a higher price is in essence a selection to forgo the 'option' of watching the presentation with both 'promotional advertisements' (ex. automobiles) and 'preceding movie trailers'.

Rejection of Rejection of Dependent Claims 135-138

Appellant's arguments regarding the dependent claims are apparently limited to being premised on the independent claims being allowable. The further remarks stating that the claims further recite additional features and or combinations which are distinct is not considered an argument under 37 CFR 41.37 (c)(1)(vii). Since the independent claims are not believed patentable over the combination of references, the dependent claims are likewise not considered to be patentable by virtue of dependency given that the combination of references meets the argued claimed limitations as previously noted.

⁴ Appellant traversed the examiners assertion that the existence of 'movie trailers' was well-known in the art (Response to Non-Final Rejection – received 29 September 2003 – Page 13, Section G; Response to Non-Final rejection – received 03 March 2006 – Page 10). An article entitled 'Movie Trailer Trash – A Brief History of the Trailer' is also of record (18 December 2003) was also provided during prosecution to support the Official Notice.

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(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

SEB


February 28, 2007

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